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09/687,157	10/12/2000	John J. Sie	19281-000800US	8624
20350 7590 09/02/2009 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER NGUYEN, PHILLIP H				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/687,157

**Applicant(s)**

SIE ET AL.

**Examiner**

Phillip H. Nguyen

**Art Unit**

2191

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4,5,7,8,10-15,17,18 and 20-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7,8,10-15,17,18 and 20-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

1. This action is reopened based on the Pre-Brief Appeal Conference decision on 6/25/2009 and in response to the amendment filed 4/10/2009
2. Claims 1, 2, 4, 5, 7, 8, 10-15, 17, 18 and 20-24 remain pending in this application and have been considered below.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1, 2, 4, 5, 7, 8, 10-15, 17, 18 and 20-24 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 14, 15, 17, 18, and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
6. Claim 14 recites "A distribution program product" which is software per se. The descriptions or expressions of the program product are not physical nor are they statutory process as they do not act being performed. Program product does not define any structural and functional interrelationship between the program product and other claimed aspect of the invention which permits the program product's functionality could be realized. Therefore, program product is merely a set of instructions capable of being executed by a computer, the program product itself is not a process.

7. Claims 15, 17, 18, and 20 directly or indirectly depend on claim 14 and therefore suffer the same deficiency.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 2, 4, 5, 8, 11-15, 17, 18 and 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,657,072 to Aristides et al. ("Aristides").

**As per claims 1 and 14:**

Aristides teaches a method for distributing content sent by a content distributor to a user location, the method comprising:

receiving a command from the content distributor to store the content at the user location before a user specifically requests the content, wherein the content comprises a subset of content available from the content distributor, the subset associated with a premium subscription service, and wherein the content comprises at least one of a video program or an audio program (see at least the abstract "**the program provider transmits at least some of the program data records to a plurality of the user interface units prior to a peak time. The program provider initiates this transmission on its own and not in response to a request from any EPG**"; see also

col. 7:59-61 **"At step 102, the headend 22 sua sponte transmits at least some of the program data records to multiple user interface units 26 prior to the peak time identified in step 100"** – *Note: Transmitting the program data records to the user locations is considered as commanding the user locations to store the program data records*);

processing the command sent from a remote location with respect to the user location (*Note: Storing the program data records at the user locations is considered processing the command* )

receiving the content at the user location (see at least the abstract **"The user interface units store the program data records in record cache for use by the EPG during the ensuing peak time"** – *Note: The program data records must be received in order to store at the user location*);

storing the content at the user location in response to at least the processing the command (see at least the abstract **"The user interface units store the program data records in record cache for use by the EPG during the ensuing peak time"**; see also col. 8:12-13 **"At step 104, the program data records are stored at user interface units 26 for use during the peak time"**); and

detecting a user action related to the content after storage of the content (see at least col. 8:19-24 **"If the viewer wishes to view the entire menu of available programs, the EPG might still request such information from the headend, but much of the demand will be met by the subset of program data records sent early**

to the EPGs").

**As per claims 2 and 15:**

Aristides teaches

wherein the content comprises at least one of a commercial, an infomercial, a show, or a movie (see at least col. 3:50-53 "**Programs provided by headend 22 might include traditional broadcast TV shows, on-demand movies, and other services...**").

**As per claims 4 and 17:**

Aristides teaches

wherein the user location comprises a set top box (see at least col. 3:56-57 "**the user interface unit is embodied as a set-top box (STB) coupled to a television set (TV) 28a-28d**").

**As per claims 5 and 18:**

Aristides teaches

wherein the storing the content comprises storing the content on a mass storage device associated with a set top box that is associated with the user location (see at least the abstract "**The user interface units store the program data records in record cache for use by the EPG during the ensuing peak time**").

**As per claim 8:**

Aristides teaches a method for distributing content sent by a content distributor to a user location, the method comprising:

determining a subset of content from a larger set of content available from the content distributor, wherein the subset of content is associated with a premium subscription service (see at least the abstract **"the program provider transmits at least some of the program data records to a plurality of the user interface units prior to a peak time"** – *Note: The subset of the program data records must be determined from a larger set of program data records available at the headend in order to transmit to the user locations*);

commanding the user location to store the subset of content from the content distributor without a user associated with the user location specifically requesting the subset of content (see at least the abstract **"the program provider transmits at least some of the program data records to a plurality of the user interface units prior to a peak time. The program provider initiates this transmission on its own and not in response to a request from any EPG"**; see also col. 7:59-61 **"At step 102, the headend 22 sua sponte transmits at least some of the program data records to multiple user interface units 26 prior to the peak time identified in step 100"** – *Note: Transmitting the program data records to the user locations is considered as commanding the user location to store program data records*), wherein:  
the subset of content is stored proximate to the user location (see at least the abstract **"The user interface units store the program data records in record cache for use**

**by the EPG during the ensuing peak time”**; see also col. 8:12-13 **“At step 104, the program data records are stored at user interface units 26 for use during the peak time”**), and

the content distributor is remotely-located from the user location (see at least **FIG. 1 “headend 20”**); and

sending the subset of content to the user location for storage before a user specifically requests the subset of content (see at least the abstract **“the program provider transmits at least some of the program data records to a plurality of the user interface units prior to a peak time. The program provider initiates this transmission on its own and not in response to a request from any EPG”**), wherein the subset of content comprises at least one of a video program or an audio program (see at least col. 3:50-53 **“Programs provided by headend 22 might include traditional broadcast TV shows, on-demand movies, and other services...”**).

**As per claim 11:**

Aristides teaches

sending usage rules for the subset of content to the user location (*Note: The program data records contains the usage rules, e.g., time and duration to play the movies*).

**As per claim 12:**

Aristides teaches



wherein the subset of content is unmentioned in a linear schedule (see at least col. 8:15-16 **“the EPG displays the programming information contained in the program data records”**; see also **FIGS. 2-3**).

**As per claim 13:**

Aristides teaches

broadcasting the subset of content to a plurality of user locations (see at least col. 7:59-61 **“At step 102, the headend 22 sue sponte transmits at least some of the program data records to multiple user interface units 26”**).

**As per claim 21:**

Aristides teaches

wherein the content distributor sends the content from a remote point with respect to the user location (see at least col. 7:59-61 **“At step 102, the headend 22 sue sponte transmits at least some of the program data records to multiple user interface units 26”**).

**As per claim 22:**

Aristides teaches

wherein the content is broadcast to a plurality of user locations, the broadcast is coextensive-in-time for the plurality of user locations, and the user location is part of the plurality of user locations (see at least col. 7:49-61 **“a peak time is identified. This**

peak time is a period when a plurality of EPGs 38 are likely to concurrently request the program data records from headend 22...At step 102, the headend 22 sue sponte transmits at least some of the program data records to multiple user interface units 26").

**As per claims 23 and 24:**

Aristides teaches

wherein the user location comprises a residence of the user (see at least col.

3:55 "Each home has a user interface unit 26a-26d").

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 7, 10, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,657,072 to Aristides et al. ("Aristides"), in view of US 6,181,867 to Kenner et al. ("Kenner").

**As per claims 7, 10, and 20:**

Aristides does not explicitly teach

wherein the processing the command comprises determining usage rules related to the content.

Kenner teaches

determining usage rules related to content (see at least the abstract "**PIM may determine specific video clip usage**").

It would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify the teaching of Aristides to incorporate the teaching of Kenner to determine usage rules related to the video. The modification would have been obvious because it would allow the system to keep track of how often a particular program data record is requested during a predetermined time interval.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip H. Nguyen whose telephone number is (571) 270-1070. The examiner can normally be reached on Monday - Thursday 10:00 AM - 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Y. Zhen can be reached on (571) 272-3708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PN  
8/25/2009

/Ted T. Vo/  
Primary Examiner, Art Unit 2191